

REMARKS

This Amendment is filed in response to an Office Action mailed on August 10, 2005 (hereafter referred to as “Office Action”). A response to the Office Action is due no later than November 10, 2005. Accordingly, this Amendment is being timely filed.

By this Amendment, applicants have amended the specification; amended claims 1, 7, 10, 17 and 18; cancelled claims 25-58 without prejudice or disclaimer; and added new claims 59 and 60. Consequently, claims 1-24, 59 and 60 are currently pending in the present application. Applicants respectfully submits that no new matter is added to the present application by the amendments to the specification and the claims provided for herein.

Cancelled Claims

Please cancel claims 25-58 without prejudice to, or disclaimer of, the subject matter presented therein. Applicants intend to prosecute said claims in divisional applications in the near future.

Claim Objection

In the Office Action, the Examiner has objected to claim 10 because of a spelling error. Applicants submit that there is no spelling error and respectfully traverse this objection. Attached as “Exhibit A” is page 64 of the present application, downloaded from public PAIR on October 11, 2005. The word “web” in line 4 of claim 10 is correctly spelled, thus applicants respectfully request withdrawal of this objection.

Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner has rejected claims 10 and 17 under 35 U.S.C. §112, first paragraph. Applicants have amended the specification and claims 10 and 17 to recite the

more accurate description “http request response headers” as suggested by the Examiner.

Therefore, applicants respectfully request withdrawal of this rejection.

Rejection Under 35 U.S.C. § 102(e)

In the Office Action, the Examiner has rejected claims 1, 3, 4, 18 and 19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0077978 A1 to O’Leary et al. (hereafter referred to as “O’Leary”). Applicants respectfully traverse that rejection.

Independent claim 1, as amended, recites, *inter alia*, “communicating computer code ... for determining if a merchant web site is a supported merchant web site.” By the Examiner’s own admission, on Page 6 of the Office Action, “O’Leary fails to specifically disclose ... determining if the merchant website is a supported merchant website.” Therefore, applicants submit that the rejection of claim 1, under 35 U.S.C. §102(e) is no longer tenable, and applicants respectfully request withdrawal of that rejection.

Applicants also submit that O’Leary discloses a system and method for adding a secure payment feature to an automatic form filling application; nowhere does O’Leary teach or suggest determining if a merchant web site is a supported merchant web site, as recited in amended claim 1. In addition, one skilled in the art, reading O’Leary would not be inclined to communicate computer code for determining if a merchant web site is a supported merchant web site, as recited in amended claim 1 because, O’Leary teaches away from communicating computer code to a user computer. Instead, O’Leary prefers to use “thin wallet technology, [where] the majority of software and databases comprising the Wallet 215 resides on a host web server” (See O’Leary, page 5, paragraph 0052).

The Examiner has not yet rejected amended claim 1 under 35 U.S.C. §103(a), but claim 1 has been amended to included a limitation of claim 7. Since claim 7 has been rejected under 35 U.S.C. §103(a), applicants submit that O’Leary fails to disclose all of the feature of amended claim 1, and that U.S. Patent Application Publication No. 2002/0062342 A1 to Sidles (hereafter referred to as “Sidles”) fails to cure that deficiency.

As mentioned above, independent claim 1, as amended, recites, *inter alia*, “communicating computer code … for determining if a merchant web site is a supported merchant web site.” Sidles, on the other hand, discloses a simple data flow monitor, existing on a user’s computer, which monitors for data packets that indicate a request for a secure page (see Sidles page 5, paragraphs 0052-0054). Computer code that determines whether a merchant web site is compatible with a wallet is not the same as a monitor that monitors data packets. In Sidles, the data flow monitor intercepts every web page request having an “<https://> …” URL and reroutes the request to a form fill proxy 400 (see Sidles, page 8, paragraph 0076). There is no determination of whether the requested page is from a supported merchant. Therefore, the computer code recited in claim 1 and the monitor described in Sidles are not the same, nor does the Sidles software monitor teach or suggest the code as claimed.

Applicants submit that Sidles does not teach or suggest determining if a merchant web site is a supported merchant website, let alone, teach or suggest communicating code for making such a determination. With reference to the rejection of claim 7, the Examiner posits, on page 6 of the Office Action that “verifying the authenticity of the vendor’s website,” as disclosed in Sidles, teaches determining whether a merchant web site is a supported merchant website. Applicants respectfully disagree. Generally, verifying the “authenticity” of the vendor’s web site is not the same as determining whether a website is a supported website. The computer code,

recited in claim 1, makes a determination as to whether a web page is from a supported merchant, while Sidles describes verifying that a webpage is from a particular website (is this page really from the site it claims to be from?), without regard or reference to the concept of a supported merchant (is this the site of a supported merchant?). These are two dissimilar functions, Sidles simply does not describe determining whether a merchant web site is a supported merchant website.

Even if, *arguendo*, the Examiner is correct, (which it is vigorously contended not be the case) the verification in Sidles does not occur at a user's computer, rather the verification is performed by a form fill proxy 400 (see Sidles, page 8, paragraph 0076). Therefore, no computer code for determining whether a merchant web site is a supported merchant web site is communicated in Sidles, while claim 1 recites communicating such computer code.

Since Sidles does not teach or suggest determining if a merchant web site is a supported merchant website, nor does Sidles teach or suggest communicating code for making such a determination, applicants submit that amended claim 1 is patentable over the proposed hypothetical combination of O'Leary and Sidles.

Independent claim 18 has been amended to recite "determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site", and is therefore similarly not anticipated by O'Leary. In addition, for the reasons stated above with respect to independent claim 1, as amended, applicants submit that independent claim 18, as amended, is not unpatentable over a hypothetical combination of O'Leary and Sidles.

Dependant claims 3, 4 and 19 depend from either independent claim 1 or 18, and are consequently not anticipated by O'Leary, at least for the same reasons discussed above with respect to the rejection of those independent claims.

Applicants also submit that defendant claim 3 is also not anticipated by O'Leary, because claim 3 recites a shopping assistant button comprising a pull-down menu. The Examiner posits on page 4 of the Office Action, that O'Leary discloses a shopping assistant comprising pull-down menus. Applicants agree with the Examiner, O'Leary teaches a separate application that acts as a "known" shopping assistant with pull-down menus, but nowhere does O'Leary teach a downloaded button on a toolbar that comprises the shopping assistant having a pull-down menu. Therefore, applicants respectfully request withdrawal of the rejection of claim 3 for at least this additional reason.

Rejections Under 35 USC § 103(a)

The Examiner has rejected claims 2, 5-14, 16, 17, 20, 21, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over O'Leary in view of Sidles, and has rejected claims 15 and 22 as being unpatentable over O'Leary in view of Sidles and the non-patent reference "Band Objects" by Microsoft. Applicants respectfully traverse these rejections.

Dependant claims 2, 5-11 and 20 depend either directly or indirectly from claims 1 and 18. Accordingly, applicants submit that O'Leary fails to disclose all of the features of claims 2, 5-11 and 20, at least for the same reasons discussed above with respect to the rejection of claims 1 and 18. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that claims 2 5-11 and 20 are not rendered obvious by the hypothetical combination of O'Leary and Sidles.

Applicants further submit that O'Leary fails to disclose all of the features of amended claim 7, and Sidles fails to cure that deficiency. Claim 7, as amended recites, *inter alia*, "communicating a supported merchant data file." Neither O'Leary nor Sidles, teaches or suggests "communicating a supported merchant data file," to a shopper's computer as recited in

claim 7. Applicants submit that defendant claim 7, as amended, is not rendered obvious by the hypothetical combination of O'Leary and Sidles for at least this additional reason.

Applicants also submit that O'Leary fails to disclose all of the features of defendant claim 9, and Sidles fails to cure that deficiency. Claim 9, recites, *inter alia*, "the computer code provid[ing] an indicator for the shopping assistant button when the Internet browser is at a supported merchant website." The Examiner, on page 7 of the Office Action, posits that O'Leary discloses computer code that provides an indicator for a shopping assistant button when the Internet browser is at a supported merchant website. In paragraph 52, O'Leary describes a participating merchant website having a wallet icon that indicates that the merchant accepts secure payments using the secure payment methods described in O'Leary. The wallet icon is not the same as the shopping assistant button for at least two reasons. First, as recited in claim 9, the shopping assistant button is part of a browser toolbar. O'Leary's wallet icon is part of a webpage not a toolbar, thus, if a user navigates to another page, the icon disappears. In contrast, a button on a browser toolbar, as recited in claim 9, remains persistent until the toolbar is removed or the browser is closed. Second, O'Leary does mention a wallet button being added to a browser toolbar (see O'Leary page 16, paragraph 0139), but nowhere does O'Leary teach or suggest providing computer code that allows that button to give a user some kind of indication that they are on a supported webpage. In contrast to O'Leary, the invention, as recited in claim 9, does recite providing such computer code.

Applicants also submit that Sidles does not cure the deficiencies of O'Leary. Nowhere does Sidles teach or suggest adding a shopping assistant button to a browser toolbar nor does Sidles teach or suggest providing computer code that allows a shopping assistant button to indicate to a user that the browser is at a supported merchant webpage. Since O'Leary does not

teach or suggest “computer code provid[ing] an indicator for the shopping assistant button when the Internet browser is at a supported merchant website” as recited in claim 9, and Sidles fails to cure that deficiency, applicants submit that defendant claim 9, as amended is not rendered obvious by the hypothetical combination of O’Leary and Sidles for at least this additional reason.

The Examiner has rejected claims 12-14, 16, 17, 21, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over O’Leary in view of Sidles. Applicants respectfully traverse this rejection. Independent claim 12, recites, “computer code operable ... for ... determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site.” Therefore, applicants submit that O’Leary fails to disclose all of the features of independent claim 12, at least for the same reasons discussed above with respect to the rejection of claim 1. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that independent claim 12 is not rendered obvious by the hypothetical combination of O’Leary and Sidles.

Independent claim 21 recites a method comprising, *inter alia*, communicating computer code that “determines if a web site to which the Internet browser is caused to navigate is a supported merchant web site.” Therefore, applicants submit that similarly, O’Leary fails to disclose all of the features of independent claim 21, at least for the same reasons discussed above with respect to the rejection of claim 1. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that independent claim 21 is not rendered obvious by the hypothetical combination of O’Leary and Sidles.

Defendant claims 13-14, 16-17 and 23-24 depend directly from claims 12 and 21. Accordingly, applicants submit that O’Leary fails to disclose all of the features of claims 13-14,

16-17 and 23-24, at least for the same reasons discussed above with respect to the rejection of claims 12 and 21. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that defendant claims 13-14, 16-17 and 23-24 are not rendered obvious by the hypothetical combination of O'Leary and Sidles.

Dependant claim 14 recites, *inter alia*, a shopping assistant button comprising a pull-down menu." Therefore, applicants submit that O'Leary fails to disclose all of the features of dependent claim 14, at least for the same reasons discussed above with respect to the rejection of claim 3. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that dependent claim 14 is not rendered obvious by the hypothetical combination of O'Leary and Sidles for at least this additional reason.

Dependant claims 16 and 23 recite, *inter alia*, a shopping assistant button that provides an indicator when the Internet browser is caused to navigate to a supported merchant website. Therefore, applicants submit that O'Leary fails to disclose all of the features of dependent claims 16 and 23, at least for the same reasons discussed above with respect to the rejection of claim 9. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that dependent claims 16 and 23 are not rendered obvious by the hypothetical combination of O'Leary and Sidles for at least this additional reason.

The Examiner has rejected claims 15 and 22 under 35 U.S.C. §103(a) as being unpatentable over O'Leary in view of Sidles and in further view of "Band Objects". Applicants respectfully traverse this rejection. Dependant claims 15 and 22 depend directly from claims 12 and 21. Accordingly, applicants submit that O'Leary fails to disclose all of the features of claims 15 and 22, at least for the same reasons discussed above with respect to the rejection of claims 12

and 21. Furthermore, Sidles fails to cure that deficiency at least for the same reasons discussed above. Therefore, applicants submit that defendant claims 15 and 22 are not rendered obvious by the hypothetical combination of O'Leary, Sidles and "Band Objects".

Applicants thus respectfully submit that the invention recited by claims 2, 5-14, 16, 17, 20, 21, 23 and 24 are not rendered obvious by O'Leary in view of Sidles, and that the invention recited by claims 15 and 22 are not rendered obvious by O'Leary in view of Sidles and "Band Objects." Therefore, applicants respectfully submit that the Examiner's rejection of claims 2, 5-14, 16, 17, 20, 21, 23 and 24 as unpatentable over O'Leary in view of Sidles, and the rejection of claims 15 and 22 as unpatentable over O'Leary in view of Sidles and "Band Objects" are no longer tenable, and respectfully requests withdrawal of those rejections. Applicants further respectfully submit that the invention recited by claims 2, 5-17 and 20-24 are not rendered obvious by any proposed hypothetical combination of O'Leary, Sidles, "Band Objects" and any other prior art of record or with the knowledge of a person of ordinary skill in the art.

New Claims

Through this amendment, applicants add new claims 59 and 60.

New defendant claim 59 depends from claim 7. Therefore, applicants submit that new claim 59 is not unpatentable over O'Leary and Sidles for at least the same reasons discussed above with respect to the rejection of claim 7, and applicants submit that new claim 59 is in condition for allowance.

New independent claim 60 is original claim 1 amended to include a limitation of defendant claim 9. Therefore, applicants submit that new claim 60 is not unpatentable over O'Leary and

Sidles for at least the same reasons discussed above with respect to the rejection of claim 9, and applicants submit that new claim 60 is in condition for allowance.

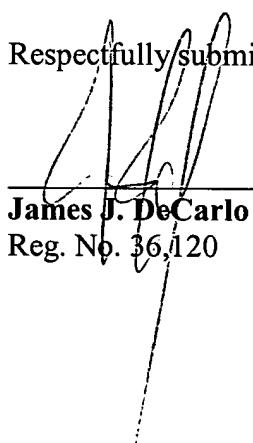
Favorable consideration for both new claims 59 and 60 are respectfully requested.

Conclusion

Applicants respectfully submit that claims in the present application (i.e., claims 1-24, 59 and 60) are now in condition for allowance, and respectfully requests reconsideration of the present application in view of the amendments to the claims, and in view of the remarks provided herein.

Early and favorable consideration of the present application is respectfully requested. If the Examiner is not in a position to allow all claims, the Examiner is urged to call the undersigned at 212-801-6729. Any additional fees or charges required at this time and in connection with the present application may be charged to Deposit Account No. 50-1561. All correspondence should continue to be mailed to the address associated with the customer number 32361.

Respectfully submitted,



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EXHIBIT A

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10. A method as recited by claim 1, wherein said step (a) further comprises communicating computer code for intercepting each web page received by the browser and determining the type of web page by HTML code and http request headers provided in the intercepted web page.

11. A method as recited by claim 1, wherein said step (e) comprises communicating a secure cookie to the computer.

12. An Internet browser interface displayable by an Internet browser on a computer display comprising:

a toolbar; and

a shopping assistant button in said toolbar and defined by computer code operable with a processor of the computer for:

intercepting an Internet address for each Internet site to which the Internet browser is caused to navigate;

determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site; and

if the web site is a supported merchant web site, automatically filling out a check-out web page of the supported merchant web site using a wallet and a supported merchant rules and mapping file.

13. An Internet browser interface as recited by claim 12, wherein said determining step comprises determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site by comparing a supported merchant data file with an Internet address for each Internet site to which the Internet browser is caused to navigate.

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